

### **REMARKS**

Reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

#### **Status of Claims**

Applicants note that the restriction requirement, which it traversed, has now been made final. Groups I and II, corresponding to claims 1-15, have been examined and rejected. Claims 16 and 18-24 have been withdrawn from consideration.

In the forgoing amendments, claims 3 and 14 have been amended to correct informalities noted by the examiner, and claims 16 and 18-24 have been cancelled without prejudice to refilling because they have been withdrawn from consideration.

Claims 25-37 are new and are directed to non-transitory computer readable media for performing the method of claims 1-13 and, therefore it is submitted, are directed to subject matter of Group I and II.

#### **Rejection Under 35 U.S.C. §112, second paragraph**

Applicants respectfully traverse the rejection of claims 3 and 14 under 35 U.S.C. §112, second paragraph, on grounds that the informalities noted by the examiner do not make the claims indefinite. Nevertheless, in order to advance prosecution, applicants have corrected these informalities and, in doing so, do not in any way admit that the informalities render the claims indefinite. Therefore, this rejection should be withdrawn.

#### **Rejection Under 35 U.S.C. §103**

All pending claims, namely claims 1-15, have been rejected as being obvious over U.S. 5,590,038 of Pitroda, in view of U.S. 5,453,601 of Rosen and in further view of U.S. 6,267,292 of Walker, et al.

Applicants respectfully traverse the rejection of claims 1-15. It is respectfully submitted that none of the references, alone or in combination, teach performing a check of eligibility requirements for processing an online balance transfer request where at least one of the eligibility requirements comprises a requirement that the first credit card account and the second credit card account not be held by related financial institutions, and declining to transfer if the balance transfer request does meet this requirement. The combination falls short of the claimed subject matter for at least this reason.

The examiner has essentially repeated the rejection of these claims made in the prior Office action based on Pitroda and Walker, et al. but has added Rosen to support further the rejection. However, Rosen does not overcome the deficiencies note above and previously identified by applicants in the remarks accompanying an amendment filed on July 14, 2009.

Applicants respectfully maintain that Pitroda does not describe anything that appears to be related to the present invention for the reasons detailed in the July 14, 2009 amendment. It describes a universal electronic transaction card (“UET card”). Because the examiner continues to cite very long passages as meeting the particular limitations set forth in the claims, applicants remain perplexed as to how the examiner is interpreting Pitroda and the claims, and thus remain convinced that its application to the claims is in error.

To underscore the fallacious reasoning being employed by the examiner, consider that the examiner admits that Pitroda does not concern transferring balances between accounts – Walker et al. is apparently cited for that proposition – or anything concerning related institutions – Rosen is cited for that proposition. Nevertheless, he says in contradiction on page 10 of the detailed action that Pitroda teaches “determining using with a business logic server, using the account data associated with the first credit account, whether the first financial institution with which the first credit account is held is related to a second financial institution with which the second credit account is held.” He follows this contradictory statement with another, as he says that Pitroda also teaches “processing the balance transfer request if it meets all of at least one eligibility requirement for transferring the balance, and otherwise not processing the balance transfer request; the at least

one eligibility requirement comprising a requirement that the first credit account as being not eligible for a balance transfer to said second credit account if it is determined that the first credit account and the second credit card account not be held by related financial institutions.”

The examiner now relies on Rosen to teach “related financial institutions,” and in support he cites a lengthy passage, lines 28-58 in column 25, as well as Rosen’s abstract and summary. The cited passage from column 25, and the abstract and summary, appear only to describe a monetary system that has electronic money that is interchangeable with conventional paper money, and a transaction money module 4, with which a customer or subscriber may access multiple accounts for deposits, withdrawals, transfers, etc., at participating banks. Although a customer can have an account at more than one bank, it is not at all clear what the relevance of these passages is to the claims, or even to the proposition for which they are cited. Plainly, these passages do not teach checking eligibility for a balance transfer and denying the transfer if accounts are held at related institutions, or suggest any desirability for preventing such transfers. Indeed, if anything they might suggest the desirability of permitting such transfers..

Finally, applicants continue to believe that, although Walker, et al. discloses a system for transferring credit or making a payment debiting the credit card of a transferor or crediting the credit card of a transferee, there appears to be no suggestion of performing any sort of check to make sure that the accounts are not held at related financial institutions.

In sum, the combination of these references plainly falls short of meeting all of the limitations in each of independent claims 1 and 14, as well as new independent claim 25, and for at least this reason.

Furthermore, it is submitted that Pitroda does not teach or suggest the limitations found in claims 2 through 13 and 15. For each of these cases, two or more long passages, as well as Pitroda’s summary and abstract, without any explanation of how these passages are being read to meet these very specific and short limitations. These passages do not appear to support the examiner’s contentions. Indeed, the examiner appears to admit as much with respect to claims 5, 6,

7, 8, 13, and 15, since he relies on Walker et al. as a backup. Unless the examiner specifically identifies where in these passages Pitroda meets each of these limitations, it will continue to believe that Pitroda does not meet them.

Applicants also respectfully submit that the cookie-cutter application to each claim of the exact same reason for modifying Pitroda with either Rosen or Walker et al. reinforces the contention made by applicants in the July 14, 2009 amendment that the examiner's motivation for combining Pitroda and Walker et al. is so generalized that it cannot provide a convincing rationale for obviousness based on the combination. To "provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holders" has little relevance to the question of whether someone of ordinary skill in the art, when considering the differences between Pitroda and the particular claimed subject matter, would find the claimed subject matter obvious, when the limitations under consideration are so much more specific than this. Furthermore, and most importantly, not only is the motivation so generalized that it cannot support a *prima facie* case of obviousness, it actually teaches away from the claimed subject matter! The claimed subject matter prevents transfers from taking place; it does not make them easier or more manageable.

In view of the errors previously noted above and the distinction between the claims and the combination of the references noted above, it is respectfully submitted that the examiner has not established a *prima facie* case of obviousness. Withdrawal of the rejection and allowance of claims 1-15 is respectfully requested.

#### New Claims

It is submitted that claims 24-37 are allowable for at least the reason that claims 1-13 are allowable. Claims 24-37 are directed to non-transitory computer media storing instructions for performing, respectively, the methods of claim 1 to 13.

Information Disclosure Statements

Applicants respectfully request an explanation for why the examiner has refused to consider much of the information disclosed by applicants, as evidenced by the return of the PTO/SM/08a forms attached to the Office action of March 24, 2010.

In view of the above amendment, Applicant respectfully submits that the present application is in condition for allowance. A notice to that effect is respectfully requested.

The Director is hereby authorized to charge any additional fees due or credit any overpayments made to Deposit Account No. 070153 of Gardere Wynne Sewell LLP, referencing 132538-1016.

Dated: August 24, 2010

Respectfully submitted,

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